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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,737	11/11/2003	John Mulloy	27049-20	4997

23643 7590 07/08/2005

BARNES & THORNBURG  
11 SOUTH MERIDIAN  
INDIANAPOLIS, IN 46204

EXAMINER
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EDGAR, RICHARD A

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,737

Applicant(s)

MULLOY ET AL.

Examiner

Richard Edgar

Art Unit

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 November 2003 under 37 C.F.R. §1.53(b).  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-13 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 17 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 9/17/2004  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Note the preliminary amendment page 2, filed 11 November 2003 which is not in compliance with 37 C.F.R. § 1.121(b)(1)(i)-(iv).

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 17 September 2004 is not in compliance with 37 C.F.R. § 1.98(b)(1). Specifically, cited U.S. Patent No. 4,473,223 was listed with an issue date 11-27-1990 having Franklin as the inventor, however U.S. Patent No. 4,473,223 issued on 09-25-1984 to Lap. The examiner notes cited U.S. Patent No. 4,973,223 to Franklin with an issue date of 11-27-1990 is also cited on the IDS.

Since the item referred to as U.S. Patent No. 4,473,223 is not in compliance with 37 C.F.R. § 1.98(b)(1), that item of information is not being considered. However, all

Art Unit: 3745

other items of information are in compliance with 37 C.F.R. §§ 1.97 and 1.98 and are therefore being considered. See attached signed copy of IDS filed 17 September 2004.

### ***Drawings***

Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 6, line 9, "figure 1" should be -- Figure 1 --.

On page 6, line 15, "Figure 3a" should be -- Figure 2a --.

On page 6, line 22, "Figure 3a" should be -- Figure 2a --.

On page 6, line 28, -- is -- should be inserted after "position".

On page 7, line 19, "Figure 5b" should be -- Figure 4b --.

Appropriate correction is required.

The above objections appear to be typographical errors that were corrected in application no. 10/117,872, but not in the instant application.

Art Unit: 3745

### ***Claim Objections***

Claims 4, 5, 6, 7, 9 and 13 are objected to because of the following informalities:

Claims 4, 5, 6, 7 and 13 use the status identifier "Presently Amended" while amending said claims in the preliminary amendment, however only the seven status identifiers listed in 37 C.F.R. § 1.121(c) may be used when amending claims. Note the listing of the status identifier "Currently amended" in 37 C.F.R. § 1.121(c).

In claim 9, lines 1-2, "the height" should be deleted. The use of "the height" appears to be a typographical error. Note the use of "the vane height" immediately after "the height".

Claim 13 should be amended as follows, similar to application no. 10/117,872:

A variable geometry turbine according to claim 1, wherein the moveable wall member is mounted in an annular cavity provided within said housing, the [maximum] inlet width [being] is defined [when] by the annular wall of the movable wall member up to the point where the annular wall lies flush with the opening of the cavity, and wherein the annular wall [member] is further retractable into the cavity.

Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

Art Unit: 3745

scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13, respectively of prior U.S. Patent No. 6,654,224. This is a double patenting rejection.


The instant application has been filed with identical claims as that of application no. 10/117,872, which has matured into U.S. Patent No. 6,652,224.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Edgar whose telephone number is (571) 272-4816. The examiner can normally be reached on Mon.-Thur. and alternate Fri., 7 am- 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Edgar  
Examiner  
Art Unit 3745

RE